

## REMARKS

Reconsideration of the above-identified application as amended respectfully is solicited on behalf of the Applicant.

Claims 1-5, 7-10 and 13 have been rejected under the first paragraph of 35 U.S.C. §112 for failure to comply with the written description requirement.

As framed by the Examiner, the basis of the rejection is that the claims as previously amended include the phrase “comprising at least **one resin** having a first melting temperature of from about 90-100°C, **a wax component** having a second melting temperature of from about 50-60°C...”

As previously made of record, the patentees believe that support for this amendment is found in the specification wherein a representative embodiment is disclosed which is based on a mixture of a resin, namely a PSA component, and an  $\alpha$ -olefinic thermoplastic component such as Vybar® 260. [See Example, Sample Nos. 3-1, 2, 3, 7, 8, and 10]. Although not termed a “wax” in the specification,  $\alpha$ -olefinic thermoplastics such as Vybar® 260 are generally considered to be waxes and are referred to as such in the following issued U.S. Patent Nos. 4,217,320 [See col. 2, ll. 59-68]; 4,515,740 [See col. 7, ll. 58-63]; 5,994,020 [See col. 13, ll. 47-63]; and 6,080,800 [See col. 7, ll. 29]. The specification also generally refers to the components of the composition described in the illustrated embodiments as “resin or wax components.” [Bunyan *et al.*, at col. 9, ll. 35-37].

*See In Re Rasmussen*, 650 F.2d 1212, 1215 (CCPA 1981), *citing In re Smythe*, 480 F.2d 1376, 1384, 178 USPQ 279, 285 (CCPA 1973) (“If the original specification of a patent application ... disclosed only a 1-pound ‘lead weight’ [as a scale counterbalance]..., we do not believe the applicant should be prevented, by the so-called ‘description requirement’ of the first paragraph of 112, ... from later claiming the counterbalance as a “metal weight” or simply as a 1-pound ‘weight’ ...”).

The Examiner, however, continues to maintain that the specification is limiting insofar as it describes “a very specific combination of materials.” To this the patentees would point out that the specification describes such combination as “one preferred embodiment” [See Bunyan, at col. 8, l. 15], and otherwise speaks to the “described embodiments” [col. 9, l. 35]. Thus, it is the patentees’ position that the specification itself is not expressly limited as to any specific combination of materials.

Moreover, the specification teaches that the phase transition temperature of the material can be adjusted by varying the ratio of the low and high melt components [See Bunyan *et al.*, U.S. Patent No. 6,054,198, at col. 8, l. 66 bridging col. 9, l. 7]. Patentees believe that this teaching reasonably conveys to one of ordinary skill that various combinations of higher melting resins

and lower melting waxes were envisioned by the applicants. *See Id.* ("The broader claim language would be permitted because the description of the use and function of the lead weight as a scale counterbalance in the whole disclosure would immediately convey to any person skilled in the scale art the knowledge that the applicant invented a scale with a 1-pound counterbalance weight, regardless of its composition.")

In view of the foregoing remarks, favorable reconsideration of the present application is earnestly solicited.

Respectfully submitted,



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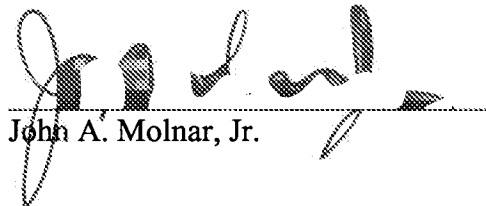
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